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# In the United States Patent and Trademark Office

## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/832,440

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Appellant: Steve Morsa

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Examiner: Jonathan Ouellette

Group Art: 3629

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PO Box 1450

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### Applicant/Appellant Reply Brief

*In 41 Pages*

This is in response to Examiner's Answer mailed 10/28/2004.

This application has been made special due to infringement.

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Steve Morsa  
Steve Morsa

## **Inventions Patentable**

*“Whoever invents or discovers any new and useful process, machine, manufacture, or compositions of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.” 35 U.S.C. 101*

Respectfully:

1.Though not provided with a Notification of Non-Compliance as per 37 CFR 1.192(c) (nor any other advisory notice) in order to correct any supposed error(s) in Appellant’s Brief [which Brief was filed prior to the recent BPAI rules changes effective 09/13/2004] and submit an amended Brief; for efficiency and expediency purposes Appellant will nonetheless make any needed and/or supposedly needed adjustments and corrections while addressing any supposedly needed clarifications, explanations, and amplifications here in the Reply Brief. Furthermore, since Appellant has not received notice that pro se Appellant’s Brief is not in compliance with any of the (other) requirements of an appeal brief, Appellant is assuming that all the (other) appeal brief requirements have been met; including the entry in to the record of Appellant’s pre-appeal-submitted four-page Exhibit A GovBenefits/BenefitsCheckUp website evidence.

Before responding to Examiner’s Answer arguments, Appellant wishes to submit the following:

### ***(5) Summary of Invention***

1. For purposes of this appeal, all the claims at issue in this appeal should now be grouped together (#7, below); thereby traversing there not being a separate summary for each claim group (Answer p.2, #5).
  
2. As summaries are not required of pro se Appellants, “ . . . unless the brief is filed by an applicant who is not represented by a registered practitioner.” (37 CFR 1.192(c)); Appellant’s previously submitted summary more than meets the minimum pre-9/13/04 pro se Brief filing requirement in this regard (which summary Examiner in any case stated in Answer p.2 is correct). Therefore, Examiner’s contention on this point (Answer p.2-3, #5) is moot.

**(7) (New) Grouping of Claims**

1. Examiner's statement that Appellant's Brief includes a statement that groupings A, C, and D do not stand or fall together is inaccurate (Answer, p.3. last paragraph). There is no such statement. The statements, "These claims (do not) stand or fall together (on its own)" referred to the individual claims within each A-E group.

2. Nevertheless; for purposes of this appeal, pro se Appellant now requests that all claims at issue in this appeal be grouped together: 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 80-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 164, 166-167, 169, 171, and 173-180. As stated, these claims do not stand or fall together.

Examiner's contentions; "... fails to provide reasons...", (Answer p.3 last para); "...why each grouping (A-E)...," (Ans.p.4, para 1); and "...fails to summarize...," (Ans.p.4, para 1) are therefore now moot. Furthermore; as stated and separately argued in the Brief; the claims of this (now sole) group do not stand or fall together and are patentably distinct; please see "(8) (Response to) Argument," following. For ease of review and consideration, the grounds for patentable distinctiveness and the resultant separate patentability of the dependent claims (addressing Ans.p.4, para 2-3 and p.19 #18-19) will be provided at the end of this Reply Brief's *Argument/Response to Argument*.

3. Please note that claims 165, 168, 170, and 172 were previously cancelled (during pre-appeal prosecution) yet inadvertently listed both in Appellant's Brief and Examiner's Answer as still being at issue. They remain cancelled and not at issue in this appeal. Appellant apologizes for the oversight.

**(8) Argument/Response to Argument**

Appellant will now continue to powerfully and convincingly traverse each and every one of Examiner's contentions/arguments and rejections, in the order (to as great a degree as is possible) in which they are presented in Examiner's Answer:

1. Examiner has added additional College Board material to the appendix and body of Examiner's Answer not previously proffered. This material has been reviewed by Appellant; including the various "snippets" of such which Examiner has merely now inserted at various places in Examiner's "(10) *Grounds of Rejections*." As it (and its snippets) merely reflects what Examiners position regarding the College Board alleged reference has been throughout this prosecution; respectfully, this material in no way adds to nor strengthens Examiner's untenable case. It is a valiant yet misplaced effort to keep afloat a "ship of obviousness" already blown full of holes . . . and on its way to the bottom of the sea. The alleged references continue to be misunderstood by Examiner; among numerous other important factors (Brief/Reply Brief). College Board does not teach a system for entities; only for individual humans (Brief). College Board (and Baker) are clearly for people; not for the matching of the many millions of businesses, governments, charities, and educational institutions, etc. with their benefits. Additionally; Examiner's continued perceived motivation to combine the alleged references and/or their teachings—" . . . to increase system effectiveness/customer service . . ."—remains nothing more than mere unsupported statement and speculation (Brief). This is especially so since the Examiner has not at all, much less reasonably, further much less convincingly, addressed how the teachings of Baker with regard to aggregating humans-only, members-only, third-party enabling organizations would have furnished one with ordinary skill in its or College Board's art with both a suggestion and a reasonable expectation of success of achieving *The Scholarship Handbook* derived, education-category-only, non-college-only matching contemplated by College Board while providing the unknown to any art, two or more (distinctly different) benefit categories, all-entities enablement of the instant invention.
2. Furthermore, since the Examiner has not set forth any merit-based basis in the Answer to reject independent claims 81, 82, or 87; and claims 101-109, 111-112, 115, 131-136, 138-139, 142-146, and 148-158 dependent thereon, the rejection of claims 81, 82, 87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, and 148-158 should be overturned:

“Only the arguments made by Appellant (here, Examiner) in the Brief (and Reply Brief) (here, Answer) will be considered and that failure to make an argument constitutes a waiver on that particular point. Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002), wherein the Federal Circuit Court stated that because the Appellant (here, Examiner) did not contest the merits of the rejections (here, Appellant arguments) in his brief (here, Answer) to the Federal Circuit court, the issue is waived.” (parenthesis supplied)

And as was forcefully stated in *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); “*We will not resort to speculation as to the examiner's position.*”

And as is further well-settled by the Board itself:

“ . . . any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn.” *Ex parte Emm*, 118 USPQ 180 (Bd. App. 1957).” 37 CFR 1.193

3. At, i.e., page 7, #7-8; p.13, #5 of Answer, Examiner makes a confusing new contention concerning the instant invention regarding the word, “unlimited.” Note first that this word is used nowhere in Appellant’s claims or specification; but only in Appellant’s arguments for the unobviousness and patentability of the instant invention (and therefore should not be read into the claims). Appellant’s use of the word in the arguments is clearly for the purpose of further clarifying that the valuable instant invention has—unlike the self-limited, constricted College Board system—no numerical limit as to the number of or type of benefit classes/categories from which the instant invention may therefore draw a no numerical limit of benefits from (as long as it’s two or more [distinctly different] classes/categories, of course). Its use is no different than the widespread use of the word/phrases, “plurality” or “more than” or “at least” in patents and the patent prosecution process; which, as is well settled, do not mean “unlimited” as Examiner is apparently choosing to define and characterize the word here. Appellant is clearly not trying to incorporate “unlimited” (omnibus language) into an automated system. Appellant is not claiming he’s invented some sort of “infinity” machine or method; and furthermore, as stated above, the word “unlimited” is not contained in either the claims or the specification. In any case (if it was even necessary to do so), it is well settled that the

best treatment of claims which are “too” broad [if that’s what Examiner is trying to say(?)] is to cite art against them.

4. Furthermore, should this contention constitute an undesignated new grounds of rejection, Appellant requests that the rules concerning such under § 41.39(a)(2) and/or any other applicable PTO rules and regulations be followed and implemented; should Appellant’s explanation and clarification above concerning “unlimited” fail for any reason to traverse such grounds of rejection (if it is a grounds of rejection; and should such traversing even be necessary).

5. While Appellant recognizes that Examiner (now) wishes the Baker alleged reference to serve as a “teaching” reference (per Answer), Appellant vehemently contests what Examiner says it is that Baker teaches (and therefore what Baker’s [or any other] art knew at the time of the instant invention). As detailed in Appellant’s Brief (p.16, para #2), Baker most certainly does not teach the matching of a multitude of benefit classes/categories directly with consumers; much less so with the additionally and further novel entities. Absent such teaching by Baker, it most certainly would not—contrary to Examiner’s statement at #8, p.14--have been obvious to one of ordinary skill in Baker’s art (nor College Board’s art; nor the instant invention’s art) to incorporate a multitude of benefit classes/categories (note the unfortunate, mistaken-meaning [see also #9(B); below] use by Examiner here of “types/classes,”) into a matching system for entities.

6. Additionally, if Examiner’s calling/treating Baker a(as) “teaching” reference should constitute a new grounds of rejection, Appellant requests that such new grounds be properly identified, addressed, and treated as such in these proceedings; and that these prosecution/appeal proceedings be properly modified/corrected to reflect such change in Baker’s status/treatment. Should such status/treatment change of the Baker alleged reference render Examiner’s Answer, in whole or in part, moot; Appellant hereby requests it be so rendered; with all the claim rejections in this appeal being accordingly reversed.

However, regardless of how Baker is treated; as a “teaching” reference or otherwise, nothing has changed. As is readily apparent, Appellant’s well-founded arguments presented throughout this prosecution still clearly overcome any and all Examiner obviousness contentions. The present invention remains obviously unobvious.

7. Examiner continues to argue (p.14-15, #'s10-12) that it would have been obvious to combine the alleged references/their teachings to produce the claimed invention. However, it should be noted that all the issues involved here have not been properly addressed—and argued--by Examiner. Specifically, the Answer states (p14, #10), “*In response to applicant’s numerous arguments that . . . ;*” thereby attempting to use only a single argument to overcome not just one, but six clear and well-founded individual, separate, and unique legal arguments against a combination of the alleged references. It is well settled that each of Appellant’s individual and unique legal grounds against the combination of the alleged references must be individually argued, or Appellant’s arguments/grounds are to be assumed accurate and correct. See *In re Berger*, supra; *In re Warner*, supra.

Of legal necessity; numerous meritorious Appellant arguments require numerous meritorious Examiner answers/counter-arguments. Where the (Appellant’s) arguments differ so widely in scope as they do here, adequate treatment requires that they be addressed by Examiner separately.

8. Specifically, the Examiner has not set forth the required reasoned basis to specifically and individually challenge:

- A. The References Do Not Contain Any Justification to Support Their Combination, Much Less in the Manner Proposed
- B. References Teach Away Proves that the Combination of the References is Not Justified
- C. Individually Complete References Proves that the Combination of the References is Not Justified

D. Different Field References (Non-Analogous Art) Proves that the Combination of the References is Not Justified

E. The Proposed Modification Cannot Render the Prior Art Unsatisfactory for Its Intended Purpose

F. The Proposed Modification Cannot Change the Principle of Operation of a Reference

Manifestly; as Examiner has failed to set forth a reasoned basis to specifically and individually challenge each of Appellant's six arguments against the combination of the alleged references; and as Appellant has set forth reasoned basis' in support of each of the six; the alleged references and/or their teachings thus cannot be combined; a factual or *prima facie* case of obviousness has therefore not been made; the present invention is accordingly then non-obvious. The claims rejections should therefore not be sustained.

9. Moreover; even examiner's general argument, were it not moot because it does not properly and legally address each of Appellant's above six arguments, would itself be without merit, since:

A. Examiner continues to misunderstand, and therefore misstate, what the alleged references teach. (please also see Brief). Indeed, it's noted that while Examiner states in one place in the Answer (Grounds of Rejection) Examiner's belief that College Board discloses/teaches entities (though it obviously doesn't), i.e., "*... discloses a system for permitting an entity to ...;*" elsewhere in the Brief (Response to Argument, i.e., p.14. #10) Examiner contradicts that statement with a different belief that College Board deals with (discloses/teaches), "*... qualified people in need ...*" The valuable and novel difference and distinction between entities and people, as stated, is of paramount valuable importance. Appellant submits that since Examiner has not taken a clear and explicit position regarding what it is that Examiner believes College Board teaches; any and all arguments utilizing the College Board alleged reference; being without the required basis; are accordingly moot; and therefore all Examiner rejections of Appellant's claims/the invention based in whole or in part on College Board should be overturned, and the respective claims allowed.

B. Examiner has now (in the Answer) incorrectly and unfortunately confused the important and valuable difference and distinction between benefit “types” and benefit “classes/categories;” i.e., inaccurately using “ . . . *benefit types/classes . . .* ” (p.15, #12). The instant invention, as defined by its independent claims, is (among its many, many other attributes) most novel and unobvious for both its all-entity enablement and its multiple (distinctly different) benefit classes/categories (i.e., like those classes/categories found in the United States Catalog of Federal Domestic Assistance: Education, Housing, Business and Commerce, Consumer Protection, Food and Nutrition, Health, Transportation, etc.); not for multiple benefit types within the same class/category; such as the Examiner-noted “ . . . *scholarships, loans, and grants . . .* ” (i.e., p.13 #2); as supplied by the limited, constricted College Board system.

C. Per the CAFC; as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness; Examiner has failed to explain the specific understanding or principle within the knowledge of an ordinary-skilled person that would motivate one with no knowledge of the instant invention to make the suggested combination of College Board and Baker (teachings); much less in the manner suggested.

D. Examiner has not set forth any basis for a reasonable expectation of success of a combination of the references; which reasonable expectation must be found in the prior art references. See *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.* 229 F.3d 1120, 56 USPQ2d 1456, (Fed. Cir. 2000) and *In re O'Farrell*, 853 F.2d 894, 903-04, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988).

10. Re: p.13 of Brief (“*Different Field References Proves . . .* ”); it is noted that not only are the two alleged references themselves from two different art groups, but the instant invention is itself from an art group different from each of the two alleged references. Specifically, the instant invention—by its own description/specification—is a system/method for matching all types of entities with all types of benefits from any number of benefit classes/categories. This is of course much different, as stated (Brief),

than the respective art groups from which the College Board and Baker alleged references are from. In *In re Clay*, 966 F.2d 656, 23 USPQ.2d 1058 (CAFC 1992); the court held that the two prior art references could not be considered to be in the same field of endeavor merely because they relate to the petroleum industry. Similarly here, the references cannot be said to be in the same field of endeavor as the present invention merely because when broadly defined they may belong to a similar industry (i.e., benefit matching).

Therefore, because the alleged references and the instant invention are most certainly all unrelated to each other—and therefore non-analogous art—there is no justification for the combination of these alleged references with each other or with the instant invention. Thus the rejections should be reversed.

Moreover; as Examiner has not even listed; much less offered any arguments in Answer or during pre-appeal prosecution contesting Appellant's repeated non-analogous art contentions/explanations; the rejection of the claims as issue should accordingly be reversed for this reason alone. *In re Warner*, supra; *In re Berger*, supra;

11. As was forcefully stated in *McGinley v. Franklin Sports, Inc.* [00-1324, 01-1113] (CAFC 04/21/2001); making it abundantly clear why else the College Board and Baker alleged references (teachings) cannot be combined (see also Brief p.26-27; *References Teach Away*):

“ . . . references that teach away cannot serve to create a prima facie case of obviousness. *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). “If references taken in combination would produce a ‘seemingly inoperative device,’ we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness.” *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).”

Specifically in the present case; any attempt to combine the alleged references with each other would most certainly result in a seemingly inoperative device (here, system/method). Indeed; how does one even begin to combine a system with no membership/association requirements (College Board) with one requiring memberships/associations (Baker)? A system with 3<sup>rd</sup> party enabling organization intermediary “gatekeepers” between the people seeking the benefits and the benefits themselves (Baker) with one with nothing between the people and the (non-college financial aid only/single class only) benefits of College Board? A system providing only those benefits available from 3<sup>rd</sup> party enabling organizations (Baker) with a system providing only benefits found in one single book (College Board)? How indeed?

Therefore; any attempted combination of the alleged references would clearly result in a seemingly inoperative system (indeed, note that the unsolvable membership/no membership paradox by itself would render the combination inoperable). Accordingly; as the above authorities make crystal clear; because the alleged references therefore teach away from the combination, they cannot serve as predicates for a prima facie case of obviousness. Thus, on this one point alone; the claims rejections should not stand and should be reversed.

It is well settled that:

The Examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption, or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173 (CCPA 1967), cert. Denied, 389 U.S. 1057 (1968).

Moreover:

The reviewing court has repeatedly cautioned against employing hindsight by using the appellant’s disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. See, e.g., *Grain Processing Corp. v. American Maize-Products Co.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988)

Furthermore:

*"It is usually, if not indeed always, easy to discover a genesis somewhere for any patentee's contribution. A thought expressed here, a hint appearing there, and a suggestion made somewhere else can always be found, after the event, and assembled to support the contention that what the patentee did was really nothing but what anyone else might do if so inclined. But if patents were to be held invalid on such reasoning, few would survive. Even the greatest invention of all time, the wheel, had, we are told, its prior art of unnumbered savages slipping on round stones. How many slipped before some bruised genius among them literally fell upon the principle of the roller, and how many more years, or centuries, passed before some succeeding genius, building upon the prior art of rollers, thought of a fixed pivot and invented the wheel, can only be surmised."* S.D. Warren Co. v. Nashua Gummmed & Coated Paper Co., 205 F.2d 602, 605 (1<sup>st</sup> Cir. 1953)

12. Since the rejection lacks any findings of reasons, suggestions, or motivations to make the modifications based on knowledge within the skill of the art at the time of the invention which would have led an artisan to combine the teachings of College Board and Baker in such a way as to arrive at the subject matter of the instant invention's independent claims, the Examiner has failed to establish a factual or *prima facie* case of obviousness with respect to each of the obviousness rejections within the meaning of 35 U.S.C. 103. Under these circumstances, Examiner's assertion that the alleged references or their teachings (or knowledge generally available to one having ordinary skill in the art) may be combined clearly lacks perceptible accuracy and should accordingly be rejected. See also, for example; *Formulating and Communicating Rejections Under 35 U.S.C. 103 For Applications Directed to Computer-Implemented Business Method Inventions*; V. Examples of Improper Rejection under 35 U.S.C. 103; p.36-40 ; PTO Website; (<http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#V.>)
13. It is important to note at this point that Applicant/Appellant early on in the prosecution powerfully—and successfully--traversed Examiner's initial "102" rejection. Despite this, the unfortunate manner in which Examiner has worded #11, p.15 of Answer could be misunderstood by some to suggest that it is only the applicant who believes the invention to be novel; "*. . . the appellant has made the argument . . . is a novel concept.*"

The undisputable fact is that it's not only the appellant who's saying so; but the Examiners as well who are in full and complete agreement that the invention is novel. The record must remain clear on this point: The present invention is novel. The applicant says so. The evidence says so. The Examiners say so. Accordingly, a more appropriate, properly accurate and definitive statement for #11 is, i.e., "Providing multiple benefit classes/categories to users is a novel concept." (Not, as stated in Answer, the meaning-changed, inaccurate, and confusing "...providing different [unlimited] benefits types/classes..." [showing here continued uncertainty/confusion over what it is Examiner believes College Board—*and now, apparently, what the instant invention*—each teach/provide]).

### **Improper/Overcome New Ground of Rejection**

14. At #13, page 15 of Answer; though not designated as such (note Examiner's *In re Van Geuns* citation); Examiner has included what appears to be a new ground of rejection. In the event this rejection/argument is allowed to be presented and considered, then, under §41.39(2)(b)(2), appellant hereby requests that this appeal be maintained, which intent is further evidenced by the filing of this Reply Brief. If for any reason, however, this new grounds is not permitted (as Appellant explains; below); or the Board decides that it should not be entered; or should not be considered; then Appellant requests that this argument be rendered moot; with the Examiner's rejection of the claims at issue in this appeal thusly and accordingly overturned.

However, whether a (new) rejection or an argument (or both); because Examiner has until the Answer ignored Appellant's repeated explanation why any possible combination of the alleged references (teachings)—were it legal and proper to combine the two (which, as stated, Appellant vehemently contests is legal or proper; or even possible)—would still not show all the valuable, useful, novel, and unobvious features of the instant invention (i.e., all entities enablement); Examiner's untimely contention here is clearly improper and should not be allowed to stand:

*“. . . if an appellant has previously submitted an argument during prosecution of the application and the examiner has ignored that argument, the examiner will not be permitted to add a new ground of rejection in the examiner’s answer to respond to that argument . . .”* Federal Register, Vol. 69, No.155/ Thursday, 08/12/2004/Rules and Regulations 49960; Comment/Answer # 68, p.21-22.

Examiners contention/argument on this point is therefore moot. Accordingly, the rejections should not be sustained.

15. However, even if this attempted new grounds of rejection/argument for any reason qualifies to be considered; which Appellant vehemently contests should not be the case; it is already a well settled maxim of Patent law that, in proceedings before the U.S. Patent and Trademark Office, claims in an application must be given their broadest reasonable interpretation consistent with the specification, and that the claim language cannot be read in a vacuum, but instead must be read in light of the specification as it would be interpreted by one of ordinary skill in the pertinent art. See *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997), (“ . . . without reading into these claims any limitations or particular embodiment which is disclosed in the specification.”); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)(“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.”); *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934,936 (Fed. Cir. 1984)(“The PTO broadly interprets claims during examination of a patent application since the applicant may amend his claim to obtain protection commensurate with his actual contribution to the art.”)(quoting *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550 (CCPA 1969)).

16. Here; respectfully; the confusing and unfounded claim interpretation urged by the Examiner is antithetical to the “entity/entities” limitation expressly recited in, e.g., claims 1, 80, 81, 82, 83, 87. There simply is no authority for such a convoluted contention given Appellant’s clear and unmistakable explanation throughout the specification, the drawings, and the prosecution that “entity/entities” is intended to mean all entities of all

types. It is well settled that to ascertain the meaning of the claims, one may look to the written description, the drawings, and the prosecution history. See, e.g., *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1324 [57 USPQ2d 1889] (Fed. Cir. 2001).

Indeed; as Examiner's own *In re Van Geuns* citation implicitly makes clear; a limitation must be in the specification in the first place; yet, "All entities of all types" isn't even in the specification. If a basis actually existed for this contention; why was it not presented long before now? Moreover, note that *In re Van Geuns* also says that during patent examination, claims are to be given their broadest reasonable interpretation. See *In re Van Geuns*, 988 F.2d 1181 and 1184, 26 USPQ2d 1057 and 1059 (Fed. Cir. 1993) (emphasis supplied); thereby in any case actually supporting Appellant's case.

As is readily seen throughout Appellant's application/specification; i.e., at page 9, paragraph 1: "'Entities' shall be understood to mean individuals, businesses, non-profits, charities, governments, educational facilities, and families; including any and all other agencies, groups, organizations, enterprises, etc. . . ." Indeed, given this definition, what else could "entity/entities" be referring to? As is well-known (MPEP, etc.); it is not permitted to give a word or phrase in a claim a definition that is other than its "plain meaning" or a meaning that is inconsistent with the way the word or phrase is used in the specification.

Moreover, "all entities of all types" appears in Appellant's argument (p.19, paragraph 3 of Brief); and, as stated, not in the specification or—as Examiner points out—in the claims, either. As is well settled, however (and as is agreed with by Examiner), the claims are interpreted in light of the specification.

Therefore, there be no need for the features upon which Appellant relies (i.e., "all entities of all types") to appear in the claims in order for the claims—in light of the clarity of the specification regarding what "entities" are—to include "all entities of all type." Making it clear in Appellant's argument that the instant invention has the unique, novel, and unobvious feature of providing benefits to other than (individual) human entities (by

saying, “all entities of all types”) serves to pointedly and starkly differentiate the present invention from and patentably over both the teachings and suggestions of College Board and Baker individually AND from and patentably over any possible combination of the alleged references or their teachings or suggestions.

Manifestly then, despite Examiner’s untenable contention to the contrary, no limitations from the specification are being read into the claims of the present invention. They don’t have to be. Accordingly, because of its antithetical impact, the Examiner’s interpretation does not comply with the requirement that a claim interpretation must be reasonable and consistent with the specification. See *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

17. Moreover; note that Examiner further continues to provide no argument against and therefore does not dispute nor contest the fact; as repeatedly pointed out and made clear by Appellant throughout prosecution; that all of the claim limitations are not taught or suggested by the applied alleged prior art (i.e., all entities enablement). See *Federal Register*, Vol. 69, No. 155, supra.

Thus; on this one point alone, a factual or prima facie case of obviousness clearly cannot be established with respect to the claims on appeal here. Accordingly and respectfully; neither Examiner’s 35 U.S.C. § 103 rejection of independent claims 1, 80, 81, 82, 87, 164, 169, 176; nor of any of the claims dependent thereon, should be allowed to stand. Examiner’s rejection of the claims of this appeal should therefore be reversed.

18. Examiner’s mere listing of some of Appellant’s arguments (page 15, #14) with a cursory copying to pages 16-18 of the Answer of parts of Chapter 700 of the MPEP does not constitute the well-settled requirement to present reasoned arguments separately arguing Examiner’s apparent belief(?) of obviousness of the invention(?). Absent such reasoned arguments; since the Examiner has not set forth any basis on which to reject any of these seven separate, distinct, and unique Appellant grounds of non-obviousness;

Examiner therefore acknowledging the full probative value for which they are justly entitled as detailed by Appellant; Examiner's rejection of the independent claims and the claims dependent thereon should be reversed. See *In re Berger*, *supra*; *In re Warner*, *supra*.

19. Furthermore, even if Examiner's mere listing of some of Appellant's arguments and sections of the MPEP constituted meritorious argument for obviousness of the instant invention; which Appellant vehemently disputes and contests is the case:

"The general rule is that administrative agencies like the PTO are not bound by the rules of evidence that govern judicial proceedings." *In re Epstein*, 32 F.3d 1559, 1565, 31 USPQ2d 1817, 1821 (Fed. Cir. 1994).

and:

"Evidence of advantages or unexpected results produced by the invention may be established by affidavit or declaration under 37 CFR 1.132 or may be submitted in unsworn form in the written description or in a reply to a rejection." See *In re Soni*, 54 F.3d 746, 750, 34 USPQ2d 1684, 1687 (Fed. Cir. 1995); referenced in *Formulating and Communicating Rejections Under 35 U.S.C. 103 For Applications Directed to Computer-Implemented Business Method Inventions*; Section III-B., p.8; *Rebuttal of the prima facie case*; PTO Website; (<http://www.uspto.gov/web/menu/busmethp/IIIB>)

Both of these two above authorities even further supporting that Appellant's well-reasoned arguments (Brief, written description, reply to rejection, Applicant/Examiners' teleconference, etc.) of Unexpected Results, Commercial Success, and Solution of Long-Felt Need (the only three of the seven arguments of objective evidence in Examiner's referenced section "I" of the MPEP which Appellant is utilizing) should be given the full probative value for which they each clearly qualify for. Additionally, it is well settled that where information and facts are obvious to the public in general; and especially so when obvious to those in the art (most) applicable to a given invention; there is no legal need or requirement for affidavits or declarations for such information and facts to be of probative value. That water is wet, a diamond hard, or the sky blue does not require affidavits or declarations to make them "probatively" so.

Specifically; the previously referenced and exhibits-provided, wildly-successful GovBenefits and BenefitsCheckUp operating embodiments of the present invention clearly demonstrate Unexpected Results, Commercial Success, and Solution of Long-Felt Need; with the additional well-known fact that the national media has for many decades now shared--in both general/aggregate form, and through individual stories--the difficult and painful realities of individuals and families in distress; yet not knowing where to go or who to turn to for all the help and assistance which may be available to them. Husbands and wives out of work. No food in the house. Sick kids who's parents have no way to pay for their medical care. Families living on the streets. This is not a question of whether or not some new crease, bend, or dimple added to some prior art object solves some obscure, supposedly long-felt need. No. Here, the long-felt need—which the instant invention obviously solves—is most assuredly unquestioned and therefore also entitled to its full probative value for this reason as well.

20. In addition, note that Appellant has also presented a full seven additional well-reasoned arguments (i.e., Brief) for the invention's non-obviousness which do not even fall under the listed categories [unexpected results, commercial success, solution of long-felt need, etc] of the Examiner-referenced MPEP "I" (p.16); namely; (1) Synergism, (2) Multiplicity of Steps Required, (3) Competitive Recognition, (4) Assumed Insolubility, (5) New Principle of Operation, (6) Different Problem Solved, and (7) Lack of Implementation. [As is seen; the Examiner listed "objective evidence" (Answer #14, p.15) is being addressed and overcome/traversed by Appellant throughout the Brief and Reply Brief.]

21. Therefore; as these seven arguments require no affidavits nor declarations to be of probative value; Examiner having not set forth any meritorious basis to traverse any of these seven arguments (*In re Berger*, supra; *In re Warner*, supra.); and Appellant having set forth a reasoned basis for each of these seven arguments; Appellant has therefore overcome any possible *prima facie* case of obviousness (which *prima facie* case

Appellant vehemently disputes and contests even exists). Accordingly, the rejection of the claims at issue in this appeal should be thusly reversed.

22. Though, as stated, no arguments regarding such by Examiner are present, therefore no position may be assumed, inferred, nor granted (*In re Berger*, supra; *In re Warner*, supra); regarding now p.17 of Answer; Appellant's Brief and Reply Brief most certainly establish that the results are unexpected and unobvious and of both statistical and practical significance. Now helping millions of people each and every year, could anyone reasonably doubt that the breakthrough, exploding popularity GovBenefits.gov service is anything but one the most ingenious, most easy to use, most socially important, most useful and valuable services—online or off—that we'll ever see in our lifetimes? Unexpected? Unobvious? Of statistical and practical significance? Yes! Yes! And double yes! Millions and millions of thrilled, lives-now-improved people (plus reduced state and federal expenditures) can't be wrong. The proof is indeed in the pudding.

23. Same now with p.18 of Answer (here regarding “I;” [#’s 16 & 17 are addressed at #’s 26-27; below]); no Examiner contentions, no arguments; therefore no Examiner position should be inferred/granted (*In re Berger*, supra; *In re Warner*, supra). In any case, commercial success (objective evidence) most certainly is commensurate with the scope of the independent claims as interpreted in light of the specification (Brief/Reply Brief). Indeed; since the Patent Office has, after careful review and consideration, made this application special based on infringement by the GovBenefits (and BenefitsCheckUp) services; and appellant has supplied proof of the great and substantial success (including Exhibit A) of the two infringing services, a clear nexus between the independent claims of the instant invention and commercial success has been both established by Appellant AND confirmed and established by the PTO itself; demonstrating once again the non-obviousness of the present invention.

24. Since Appellant is pro se; and therefore no attorney/counsel statements are being made, “II. Attorney Arguments Cannot Take the Place of Evidence” (Page 16 of Answer) is obviously moot.

25. However, note that even if any of the above grounds for the non-obviousness of the instant invention weren't accorded the full probative value for which they are clearly entitled; which Appellant vigorously and vehemently maintains should be the case; all these many and varied Appellant grounds would still possess and provide their full probative value under the applicable section of 716.01(c) "III," as follows:

#### **716.01(c) Probative Value of Objective Evidence [R-2]**

#### **III. OPINION EVIDENCE**

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. (emphasis supplied) *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

See also, for example, *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953); where arguments of an applicant as to the advantages of his or her claimed invention cannot be disregarded for this reason alone. See also *In re Epstein*, supra; *In re Formulating and Communicating Rejections . . . ,* supra.

While it's recognized that Applicant has an obvious interest in the outcome of this appeal; such interest in no way negates the supplied overwhelming contentions, arguments, factual support and reasonings in support of Applicant's position regarding the present invention's unobviousness. Moreover; Examiner neither provides any arguments against nor offers any evidence of any type in opposition to that of applicant's assertions. Therefore, since the Examiner has not set forth any basis to nullify or traverse appellant's substantial evidence of unobviousness (*In re Berger*, supra; *In re Warner*, supra); while Appellant has most certainly established the instant invention's

unobviousness; the present invention is non-obvious and the rejection of the claims at issue here should be overturned.

26. At page 18, #16-17 of Answer, Examiner again inappropriately attempts to use a single argument to overcome multiple unique and meritful Appellant arguments; here contending that five of Appellant's powerful arguments (Assumed Insolubility, New Principle of Operation, References Teach Away, Different Problem Solved, Lack of Implementation) should simply be "swept away" by the continued untenable contention of Examiner that the cited alleged prior art teaches the claimed invention.

27. First, as stated and clearly demonstrated previously by Appellant (Brief/Reply Brief), the cited art (nor knowledge known to the art) already in no way discloses, teaches, or suggests the claimed invention. Second; Examiner has, as stated, here made none of the required specific and independent arguments against each of these five Appellant arguments/contentions. Thereby not contesting the full probative value that each of these five arguments are so clearly entitled to. *In re Berger*, supra; *In re Warner*, supra. Accordingly; each of the independent claims are clearly and most certainly unobvious and patentable over the cited alleged references. Thus, the claims rejections should not be sustained.

### **The Separate Patentability of the Dependent Claims**

28. As stated; claims 1, 16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 80-87, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 148-158, 164, 166-167, 169, 171, and 173-180 do not stand or fall together.

29. As Examiner has not meritoriously argued against the separate patentability of each individual dependent claim in the Answer; much less with any reasonable degree of specificity (making only a very general contention under "Grouping of Claims" that the claims should stand or fall together [i.e., p.4]); Appellant respectfully submits that the rejection of all of the dependent claims (16-24, 26-27, 30, 46-52, 54-55, 58-62, 64-74, 80-86, 101-109, 111-112, 115, 131-136, 138-139, 142-146, 146-158, 166-167, 171, and 173-175, 177-180) the subject of this appeal should for this reason alone be overturned

and the claims allowed. See *In re Berger*, supra; *In re Warner*, supra; *Ex parte Emm*, supra.

30. Regardless; though Appellant has certainly already successfully argued (i.e., Brief) the separate patentability of the dependent claims; in order to address Examiner's confusing contention(s) that Appellant has yet to do so (Answer, p.3-4; and p.19); Appellant will nonetheless here even further explain and expand on why and how the dependent claims are themselves separately patentable. As stated; the dependent claims are all also *a fortiori* patentable; additionally disclosing and teaching subject matter (via additional limitations in addition to those of the instant invention's independent claims) which is entirely foreign to College Board, Baker (their disclosures, teachings, or suggestions); or any possible combination thereof (Brief, p.28). For ease of review and consideration (i.e., not having to go back and forth between the Reply Brief and the Brief to read and consider Appellant's grounds in support of the novel, unobvious, and useful dependent claims), Appellant's separate-patentability grounds are respectfully presented as follows:

31. Dependent claims 16 & 101 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type and number of benefit providers. The benefits applicable to the entities may be displayed to the entities in a number of manners; including according to benefit class/category, the value of the benefits, the cost (if any) of the benefits; the importance, relevance, ease of use, expiration (date) of, creation (date) of the benefits; types of benefits, and physical proximity of the entities to one or more of the benefit providers. Providing more useful, more effective manners of benefit presentation to entities than that of the independent claims of the instant invention is a valuable improvement over a mere random display of the benefits as would commonly occur with conventional computer outputs. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in

substantially real time, with the results presented to the entity in one of a number of different formats of organized presentations. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 16 and 101 are thus separately patentable.

32. Dependent claims 17 & 102 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers. The benefits applicable to the entities may be displayed to the entities in a number of manners of each entity's choosing; including according to benefit class/category, the value of the benefits, the cost (if any) of the benefits; the importance, relevance, ease of use, expiration (date) of, creation (date) of the benefits; types of benefits, and physical proximity of the entities to one or more of the benefit providers. This is a valuable improvement over a random display of the benefits as is seen with the independent claims of the instant invention; providing entities with the ability to self-select the manner of benefit presentation which is most advantageous to each entity. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, with the results presented to the entity in an organized presentation format of an entity's choosing. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 17 and 102 are thus separately patentable.

33. Dependent claims 18-19 & 103-104 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers. Some or all of the entity's benefit-search results are stored in the system for entity's future viewing and use. This is a valuable improvement relative to the independent claims of the instant invention; where entities must complete a new questionnaire each and every time entity wants to use the system. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, with some to all of the entities benefit results stored in the system so that entities are saved from having to repeatedly complete up to 50 or more questions—possibly requiring tracking down paperwork and data like pay stubs, bank balances, etc in order to complete the requisite questionnaire—over and over again every time entity wants to discover what benefits entity does or may qualify for. Further, there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 18-19 and 103-104 are thus each separately patentable.

34. Dependent claims 20-21 & 105-106 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers. Some or all of the entity's benefit-search results are stored outside the system for entity's future viewing and use. This is a valuable improvement over the system of the independent claims of the instant invention; where entities must complete a new questionnaire each time entity wants to use the system; where such results are stored within the system.

Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, with some to all of the entities benefit results stored outside the system so that entities are saved from having to repeatedly complete up to 50 or more questions—possibly requiring tracking down paperwork and data like pay stubs, bank balances, etc in order to complete the requisite questionnaire—over and over again every time entity wants to discover what benefits entity does or may qualify for. One advantage of the results being stored outside the system is that system resources for the storage and maintenance of these records are not utilized. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 20-21 and 105-106 are thus each separately patentable.

35. Dependent claims 22-24 & 107-109 are independently patentable over the alleged references because Baker (C10 L59-67, C11 L1-15) does not teach what OA #15 believes that it does. Specifically, L59-60 discloses, “*... process is performed on a periodic basis to inform consumers ...*” and (L63) “*... daily, weekly, or monthly.*” Showing that this “updating” aspect of Baker is therefore *time-interval-based*. The present invention discloses, on the other hand; automated, entity changed(ing)-status, *event-based* updating, as seen in paragraph 4, page 15 of the present invention’s specification:

“In a preferred embodiment, the system includes means to notify system users, via suitably enabled input/output devices 420, of any modification or elimination of existing benefits; or the availability of any new benefits; or the pending modification or elimination of existing benefits; or pending availability of new benefits. In this way users 430 will be constantly kept up to date on the benefit(s) or benefit class(es) most important to them.”

And this from its *Example* (paragraph 1, page 18 of specification) :

“Optionally, Dawn may request real time updates of the benefit information via such means as e-mail, FAX, pager, hard-line or web-enabled phone, PDA (Personal Digital Assistants such as the Palm®), etc.

Then, the benefit information applicable to her will be automatically updated as the information gathered from the benefit providers is updated." [Emphasis supplied.]

The distinction is an important one. With Baker (unless one run updates constantly, 24 hours a day, 7 days a week); and especially so since so very many benefits are time-sensitive; who knows what's available to who for how long and under what conditions, concerning one's benefits at any given time? With this valuable feature enabled in the present invention, one always knows (and *without having to run updates*). This system superiority is clearly entirely foreign to Baker and College Board, or any combination thereof.

C10 L64-67 through C11 L1-7 of Baker merely discloses that a consumer may interact either directly or indirectly with the system; while C11 L8-15 merely discloses that the system's benefit information and *time-interval based* updates may be provided or made available to a consumer via any suitable format/delivery means, e.g. postal mail, e-mail, computer bulletin board, etc.

Moreover; dependent claims 22-24 & 107-109 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; whereby entities are furthermore able to receive automated, entity changed(ing)-status, event-based updating of the benefit information applicable to each individual entity. This is a valuable improvement relative to the system of the independent claims of the instant invention; where entities must complete a new questionnaire each time the entities want to be updated on the benefits they (may) qualify for. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where the entities are automatically kept continuously current and up-to-date on the benefits entity (may) qualify for.

Further; as stated; there being not even a single mention or suggestion of such; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 22-24 and 107-109 are thus each separately patentable.

36. Dependent claims 26-27, 50, 111-112, 134, 166, 167, 171, and 174 disclose system/methods wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; where the benefits message displayed to an entity does not specify at least one benefit and/or one benefit provider and/or the contact information of at least one provider. Not specifying one or more benefits and/or their providers and/or the provider(s) contact information means withholding their identification/contact information from the entity which would otherwise normally be disclosed to the entity in the benefit display. Such anonymity at this initial disclosure stage (will) provide(s) an important system advantage to at least some of the benefit providers desiring to withhold their identity and/or the benefit(s) they're offering and/or their contact information until a later stage of the benefit discover/delivery process. This is a valuable improvement over the system of the independent claims of the instant invention; where benefit providers must disclose who they are, what they're offering, and how to contact them at the time of initial display to an entity of the benefits for which an entity (may) qualify for. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where one or more of the benefit providers and/or their benefits and/or their contact information is/are not initially identified to the benefit seeker. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other.

Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 26-27, 50, 111, 112, 134, 166, 171, and 174 are thus each separately patentable.

37. Dependent claims 30 & 115 are both independently patentable over the alleged references AND independently patentable generally because; while web-commerce (internet payment systems) were well known by the time invention was made, never before have the income-generation methods disclosed in new claims 30 and 115 ever existed. Now--for the first time ever--a benefit-matching system doesn't have to be advertisement-based or fee-based (or rely on tax dollars like the GovBenefits service does, or on contributions, as the Benefits Check Up service does [recently adding other conventional income-generating systems to their service]). Instead, *the benefits themselves* can supply the revenue needs of the system; freeing the system/company from investing what often proves to be large—sometimes crippling—expenditures in time, effort, and money to build an advertising-supported system. Just as difficult is trying to get people and other entities to pay for the use of such a system before they see if the benefit information/ benefits they receive even make it worth the cost. As has been amply and repeatedly reported in the media since the dawn of web-based payment systems, precious few web-based companies have been able to make the subscription model work. Most companies trying to use subscriptions quickly lose up to millions of dollars, find themselves drowning in debt, and go out of business.

Basically, with this teaching, the invention can be set up as a “pay-only-for-results” system/method. If a person/entity actually qualifies for and is able to obtain one or more benefits, they share some portion of what they receive with the system operator; if not, the entity has incurred no costs of any type for using the system. Most people love paying only for results when such an option is made available to them. Such new, valuable, and unexpected results are clearly superior to what has existed before.

Additionally, applicant submits that the specific recitations of various payment/income options for the invention within the specification does in fact provide the necessary and required support for new claims 30 & 115: “*FIG. 3 is a flow chart . . . Further, central controller 200 charges user's credit or debit card and updates billing information in the user information database 200 to reflect the “purchase” (transmission) of requested benefit information. It is to be understood that numerous other alternative charging/billing and income-generation methods may be used without detracting from the scope of the present invention . . . per benefit received, a percentage of benefit(s) utilized . . . per benefit viewed, per benefit utilized basis, . . .*” from page 13/*Detailed Description of the Invention.*

While it’s true that the present invention would work regardless of how the entity paid for system access and use; as *dependent* claims, an exciting new and improved set of payment/income methods could be used to produce valuable new and unexpected results (including no subscription fees for entity use of system, lower system operational costs, and fewer-to-no advertising difficulties). The entities, the benefit providers, and even the system (operator) itself would all benefit.

As can now be seen, the unique and non-obvious payment/income methods of new/rewritten claims 30 and 115 *are* functionally involved in the steps recited; having both functional manifestation and novel relation to the invention’s structure and operation and making them patentable over College Board and Baker; and therefore allowable under Section 103. Therefore, *In re Gulack* and *In re Lowry* do not apply to new claims 30 and 115. This “pay-only-for-(benefit)results” disclosure is entirely and completely foreign to College Board, Baker, or any combination thereof.

Furthermore; such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where (unlike as is the case with the independent claims of the instant invention) payment for system use is derived not via conventional payment

methods; but instead from the benefits themselves. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 30 and 115 are thus each separately patentable.

38. Dependent claims 46 & 131 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers. The providers themselves—or 3<sup>rd</sup> party intermediaries acting on their behalf and/or the behalf of the system operator—pay for access/use of the system. This is a valuable improvement over the system of the independent claims of the instant invention; i.e., where—now; entities—some percentage of such who could otherwise have difficulty affording an “entity pays” system—can thereby have easier access to the system. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, with some to all of the cost of the system being born by one or more of the benefit providers. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 46 and 131 are thus each separately patentable.

39. Dependent claims 49 & 133 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers. The benefit providers address(es), contact information, and a map/directions to the provider(s) are provided.

This is a valuable improvement over the system of the independent claims of the instant invention; where entities must figure out for themselves how to get in contact with—and even physically visit where possible/desirable—the providers who have benefits the entity is or appears to be qualified for. Such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, with contact/location/map information like this to ease the acquisition of benefits by the entities. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 49 and 133 are thus each separately patentable.

40. Dependent claims 51, 52, 135, 136 are both independently patentable over College Board/EXPAN/Baker (in any combination) AND independently patentable generally because; while it's true that links predate the invention; using them to access any required benefit provider application forms can at times be surprisingly problematic. Links are often known to "break;" directing visitors to either no site, the wrong location in often 100+page benefit-provider web sites, or to wrong sites entirely. Also, while most of the 2<sup>nd</sup> OA directs itself to College Board and Baker; as is made clear in the present invention's specification, many of the invention's potential benefit providers may choose to keep their identity hidden from various benefit-seeking entities. Unlike with links to benefit provider forms found at the providers' own websites, application forms made available instead as part of the benefit search results could easily maintain this confidentiality.

Next, note that College Board's EXPAN system, unlike their Scholarship Search system, is a combination online/offline system which is not web based. To use EXPAN requires a personal meeting with a counselor or other school official to complete the requisite questionnaire; or the taking home of a disk to do the same thing. The information is then

either mailed in or transmitted—apparently over phone lines to a BBS--via the use of proprietary software. Trying to use such a system to obtain timely help in completing sometimes very complicated benefit application forms would be unwieldy in the least; near impossible in the worst.

Therefore, the result of the present invention's superior ability to more quickly and easily—and, when needed/desired—*privately and confidentially*--provide the actual application forms and assistance in completing them produces new, valuable, exciting, and unexpected results.

Thus applicant submits that this important and valuable invention option is much more than merely a combination of College Board and/or EXPAN (and/or Baker) with links; and that--under 35 USC 103—the distinguishing matter of claims 51, 52, 135, and 136 are also entirely foreign to College Board, EXPAN, Baker, or any combination thereof.

Furthermore; such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where one or more of any needed benefit application forms (with assistance to complete them) are; unlike as is the case with the independent claims of the instant invention; provided via the system directly to the entities. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 51-52 and 135-136 are thus each separately patentable.

41. Dependent claims 54 & 138 are both independently patentable over the alleged references AND independently patentable generally because they recite a deeper, more comprehensive (and much more valuable) involvement between the entities and the

benefit providers once the benefits applicable to the entities have been identified by the system. College Board and Baker teach only the (limited, as stated) *identification* of benefits (for individuals). Yet, once the benefits have been identified, what next? Should the entity call, or visit, or mail the providers? Who should they ask for? What department? Which office/location? How does one get the forms? Can someone help complete them? What if they have more questions? How does one receive the benefits? By mail? Fax? Personal visit? Tough enough for those with full/normal physical emotional/psychological abilities; what about the handicapped? What are they to do? Claims 54 and 138 make all these logistical difficulties simple for anyone who needs or desires them. The alleged references; there not being even a single mention or suggestion of this valuable limitation in either College Board or Baker; whether taken individually or in combination with one another; neither disclose, teach; nor even suggest; any of this novel, unobvious capability. Only the present invention.

Furthermore; such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where; unlike as is the case with the independent claims of the instant invention; an entity may at entity's option receive any of the wonderful "easier access and use" advantages listed in these dependent claims. Since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 54 and 138 are thus each separately patentable.

42. Dependent claims 58, 59, 142, & 143 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; with entities being able to share their benefit information and/or benefits with others via the system and an internet. This is a valuable improvement over a system where; as is the case with the independent claims of the instant invention; entities must figure out for themselves how to—where doing so is worthwhile for entities—share the information/benefits they've identified.

Such a useful, time and trouble saving system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, where the benefits information and even the benefits themselves (vouchers, certificates, coupons, etc) may be shared with others using the system over an internet. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 58, 59, 142, and 143 are thus each separately patentable.

43. Dependent claims 60, 61, 144, & 145 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; with entities being able to discover and acquire/use *no-qualifying-needed* benefits. This is a valuable improvement over a system where; as is the case with the independent claims of the instant invention; entities are able to locate/identify and obtain benefits only for which they're qualified/eligible to receive. Such a useful and valuable system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefits and benefit information, in substantially real time; wherein one or more of the benefits disclosed to an entity require no acquisition, utilization, or eligibility requirements. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other.

Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 60, 61, 144, and 145 are thus each separately patentable.

44. Dependent claims 62 & 146 are independently patentable because the system/method incorporating such teaches an even more encompassing disclosure of the system's benefits to an entity. By displaying "may, may not, does and does not qualify for benefits," an entity can, i.e., discover additional benefits which entity could—by, for example, adjusting its preferences—qualify to obtain which they otherwise wouldn't even know about. Or, if an entity (human in this case) was turning 65 in a few months and wanted to know what government benefits were going to "kick in" at that time. It's a way to see what benefits a given entity is or may be *close to being qualified* to receive (or, conversely; not close to qualifying for). Such a useful and valuable system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefits and benefit information, in substantially real time; wherein; unlike as is the case with the independent claims of the instant invention; one or more entity may, may not, does, does not qualify-to-obtain benefits is disclosed in entity's benefit list/display. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 62 and 146 are thus each separately patentable.

45. Dependent claims 64 & 148 are independently patentable because a system/method incorporating the availability of benefits without regards to an entity's data set; and whether or not entity qualifies for or is eligible for any benefits is completely foreign to the prior art. This ability allows an entity to discover which benefits are available via the system; which would, for example, help entity to decide whether or not to use the system (especially valuable where the entity must pay in order to use the system). Only the present invention—with these two claims—allows a benefit-seeking entity to have a "sneak peek" at potentially "all" the benefits available via the system. Such a useful and valuable system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network

system that conducts a search of multiple sources of benefits and benefit information, in substantially real time; wherein; unlike as is the case with the independent claims of the instant invention; benefits (information) is disclosed to entity without regards to entity's data set. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 64 and 148 are thus each separately patentable.

46. Dependent claims 65, 66, 149, & 150 are independently patentable over both the alleged references AND over the art generally since they teach wherein one or more of said benefit providers may at benefit providers option submit said benefit information either directly into said system or via one or more 3<sup>rd</sup> party intermediaries. The ability of benefit providers and the system (operator) to greatly reduce or eliminate human involvement and interaction in, for example; the identification of, gathering of, inputting in (to the system), and managing and updating of the benefits information and/or the benefits is of tremendous cost-saving and operational efficiency value. There being not even a single word or sentence concerning this novel and unobvious teaching in either alleged reference; such valuable, *produces-new-and-unexpected-results* benefit-provider direct submission is clearly and entirely foreign to College Board, Baker, their teachings, their suggestions; or any combination thereof.

Furthermore; such a useful system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefit information, in substantially real time, wherein; unlike as is the case with the independent claims of the instant invention; provider benefit information may be submitted directly by the benefit providers themselves or via one or more 3<sup>rd</sup> party intermediaries. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references;

either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 65, 66, 149, and 150 are thus each separately patentable.

47. Dependent claims 67 & 151 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; with entities being able to select the frequency of system updates concerning at least one benefit and/or one benefit class. This is a valuable improvement over a system/method such as that as defined by the independent claims of the instant invention; where entities are unable to self-select how often they receive updates on the benefits or benefit classes most important to them; where, for example; one who's seeking a car, or perhaps a house, would be unable to keep "up to the minute" on any special offers from car dealers or new-home builders as to the availability of and cost of their respective products/offerings. Such a useful and valuable system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefits/benefit information, in substantially real time; wherein the entities can choose how often to receive updates on the benefits and/or benefit classes most important to them. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 67 and 151 are thus each separately patentable.

48. Dependent claims 73, 74, 157, & 158 disclose a system/method wherein entities are matched in real or substantially real time via modems over a computer network with multiple classes/categories of benefits information and benefits offered and provided from any type of and number of benefit providers; with entities able to receive and/or

utilize via an internet those benefits able to be transmitted/delivered in such a manner (i.e., certificates, coupons, vouchers, monetary equivalents). This is a valuable improvement over a system/method such as that as defined by the independent claims of the instant invention; where entities must, for example, wait on time and effort-consuming mail, personal visits, or other “physical delivery” methods to receive such benefits. Such a useful and valuable system/method is novel and unobvious over previous inventions and knowledge generally known to the art in that never before has there been a network system that conducts a search of multiple sources of benefits/benefit information, in substantially real time; wherein at least some of the entities benefits may be delivered and/or utilized via an internet. Further; there being not even a single mention or suggestion of such in either College Board or Baker; this additional limitation is not disclosed, taught, or suggested by the alleged references; either individually or in combination with each other. Therefore, since these claims disclose a specific system/method neither shown nor suggested in the art(s) and are therefore patentably distinct; claims 73, 74, 157, and 158 are thus each separately patentable.

49. Applicant respectfully submits that since the above listed dependent claims are each therefore patentably distinct and accordingly separately patentable, they should be allowed. Thus; if any rejections of any dependent claims (still) exist (which Appellant vehemently contests should be the case); such rejections should not be sustained.

50. For all the many wide, varied, and substantial reasons above, in Appellant’s Brief, and throughout its prosecution; even if based on the record as a whole (which Appellant vigorously and vehemently contests and disputes is even necessary given the clear lack of either a factual or *prima facie* case of obviousness having been established); given Appellant’s overwhelming case verses Examiner’s very weak case; Appellant’s instant invention is clearly unobvious; and the rejections should not be sustained.

51. Finally; since Examiner has not maintained in the Answer a number of rejections, contentions and arguments which Examiner made in previous office actions, Appellant submits that any and all such Examiner rejections, etc., have been successfully traversed by Appellant; have been withdrawn and/or waived by Examiner; and should accordingly

receive no further consideration in the prosecution of this application. See *In re Berger*, supra; *In re Warner*, supra; *Ex parte Emm*, supra.

## Conclusion

Respectfully, nothing has changed. Examiner's arguments still fall far short. The case for the present invention's non-obviousness remains overwhelming and unassailable. Indeed, Examiner's 10/28/2004 Answer has actually made Appellant's case even stronger than it already was. Though only one or two be needed; in total, as has now been detailed, explained, argued; and the basis therefore clearly established and demonstrated; both in Appellant's Brief, Reply Brief, and prior filings, there are now no fewer than 28 grounds for overturning the rejections.

### Specifically:

1. Independent claims 81, 82, and 87; along with claims 101-109, 111-112, 115, 131-136, 138-139, 142-146, and 148-158 dependent thereon, are automatically allowable, as Examiner has set forth no reply nor argument regarding such in Answer; and therefore no basis to reject them exists.
2. There is no justification to support the suggested combination of the alleged references or their teachings; much less in the manner proposed.
3. References Teach Away Proves that the combination of the alleged references or their teachings is not justified.
4. Individually-Complete References proves that the combination of the alleged references or their teachings is not justified.
5. Different-Field References (Non-Analogous Art) proves that the combination of the alleged references or their teachings is not justified.
6. That the proposed modification would render the alleged prior art unsatisfactory for its intended purpose proves that the combination of the alleged references or their teachings is not justified.
7. That the proposed modification would change the principle of operation of a reference proves that the combination of the alleged references or their teachings is not justified.
8. Improper/Overcome New Grounds of Rejection.

9. That the alleged references continue to be misunderstood by the Examiner proves that the combination of the alleged references or their teachings is not justified.
10. Examiner did not take a clear and consistent position on what it is Examiner believes College Board discloses/teaches; thus, all Examiner arguments utilizing this alleged reference are moot.
11. Even if the alleged references and/or their teachings were to be combined in the manner proposed (or in any other manner); the proposed combination (or any other combination) does not (and would not) show all the novel features of the present invention.
12. The novel features of the independent claims produce new and unexpected results and hence are unobvious and patentable over these alleged references under 35 USC 103.
13. The required factual basis or *prima facie* case of obviousness has not been established.
14. Examiner has made no merit-based arguments contesting the invention's objective evidence of non-obviousness.
15. Overwhelming Objective Evidence of non-obviousness is present.
16. Commercial Success proves non-obviousness over the alleged references/their teachings or suggestions.
17. Solution of Long-Felt and Unsolved Need proves non-obviousness over the alleged references/their teachings or suggestions.
18. Synergism proves non-obviousness over the alleged references/their teachings or suggestions.
19. Multiplicity of Steps Required proves non-obviousness over the alleged references/their teachings or suggestions.
20. Competitive Recognition proves non-obviousness over the alleged references/their teachings or suggestions.
21. Assumed Insolubility proves non-obviousness over the alleged references/their teachings or suggestions.
22. New Principle of Operation proves non-obviousness over the alleged references/their teachings or suggestions.
23. Different Problem Solved proves non-obviousness over the alleged references/their teachings or suggestions.

24. Lack of Implementation proves non-obviousness over the alleged references/their teachings or suggestions.
25. Examiner has set forth no basis, much less so based on any merits, for the rejection of the dependent claims.
26. The dependent claims are a fortiori patentable over the alleged references.
27. The dependent claims are themselves each separately patentable.
28. Even if based on the record as a whole, the present invention is unobvious.

Accordingly, it is submitted that all rejections the subject of this appeal should therefore be reversed and the claims allowed; which Appellant respectfully requests.

As demonstrated well with over 100,000 being issued each year in the United States; respectfully; one does not have to create an invisibility machine or turn lead into gold in order to receive a patent. Applicant's invention meets all the conditions and requirements to receive a patent and join these 100,000+ others in 2005. 35 U.S.C. 101

In closing, I would like to thank the Board in advance for its work on this appeal; while standing ready to address any matter that is deemed appropriate for the Board's reasoned decision on this appeal. I also wish to express my appreciation to the hard-working Examiners who've worked with me during this prosecution. Though we obviously have very different viewpoints on the patentability of the present invention, they've always been helpful to me along the way; conducting themselves at all times in a friendly, professional manner.

Respectfully submitted,



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